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In re Application of	:	
TSAI et al.	:	
Application No.: 10/583,179	:	DECISION
PCT No.: PCT/SG2004/000417	:	
Int. Filing Date: 17 December 2004	:	
Priority Date: 19 December 2003	:	
Attorney Docket No.: 490352-3004/US	:	
For: PROTEIN SEPARATION DEVICE	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 25 August 2008 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

### **BACKGROUND**

On 17 December 2004, applicants filed international application PCT/SG2004/000417, which designated the United States and claimed a priority date of 19 December 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 30 June 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 19 June 2006.

On 16 June 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 25 February 2008, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 25 August 2008, applicants filed a petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing

inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been met.

Item (2) has not been met. It is not clear whether it is being alleged that Hon-Chiu Eastwood Leung refuses to execute the application or that he cannot be reached after diligent effort. The two are distinct. *See, e.g.,* MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." It is not clear that the package sent to Mr. Leung's last known address on 15 August 2007 (paragraph 2.b. of petition) was received by him. No form of return receipt or tracking appears to have been used.

If it is being alleged that Mr. Leung refuses to sign, it is required that he be presented with the application papers (specification, including claims, drawings, and oath or declaration). *See* MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." Here, it appears that Mr. Leung was only presented with a Declaration and Assignment (paragraph 2.b. of petition). Additionally, MPEP § 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

No statement of facts by a person having firsthand knowledge has been presented.

If it is being alleged that Mr. Leung cannot be reached or found, MPEP § 409.03(d), item I, states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

...  
The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, no statement of facts has been provided by a person having firsthand knowledge nor has any documentary evidence been provided.

**CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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